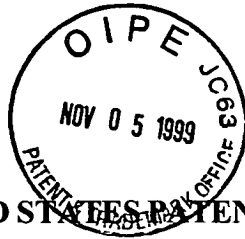


Docket No.: 50429-281



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

AKIHIKO TAKABATAKE, et al.

Serial No.: 08/908,599

Group Art Unit: 2713

Filed: August 08, 1997

Examiner: Y. Lee

For: PICTURE DECODING & DISPLAY UNIT INCLUDING A MEMORY HAVING  
REDUCE STORAGE CAPACITY FOR STORING PIXEL DATA

PATENT  
RECEIVED  
NOV - 8 1999  
TECH CENTER 2700  
#7  
Rose  
11-299

RESPONSE

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

Claims 1 through 13, 15 and 18 through 28 remain pending in this application. Claims 4 through 7, 11 through 13, 15, 18 through 20 and 24 through 26 stand withdrawn from consideration as not being directed to the elected invention. Claims 1 through 3, 8 through 10, 21 through 23, 27 and 28 stand rejected as set forth in the Office Action dated August 6, 1999. Favorable reconsideration of these rejections in light of the following comments is respectfully solicited.

Claims 1 through 3, 21 through 23, 27 and 28 have been rejected under the second paragraph of 35 U. S. C. §112. The statement of the grounds for rejection in the present Office Action refers back to a previous Office Action for explanation. The previous Office Action, in turn, refers back to a yet earlier Office Action, dated January 21, 1997. Page 4 of that Office Action, which apparently remains as the basis for rejection, states that the rejection is made on the ground that the claims are not directed to the elected subject matter,

OK ( but rather to embodiment 1 as disclosed at pages 25-44 of the specification. It is submitted that the statement of the rejection in that Office Action and, by reference, in each of the succeeding Office Actions does not purport that the subject matter recited in these claims cannot be understood, but rather that they are not readable on the elected species of invention. Yet the claims have been rejected, as opposed to having been held withdrawn as not readable on the elected species. It is submitted that the procedure undertaken in the Office Action is inappropriate to support the position taken. Moreover, it is urged that the claim recitations meet the requirements of the cited paragraph of the statute and are readable on the elected species of the invention.

In review, the elected species (see the response of January 2, 1997) is readable on Figs. 11-15. Fig. 12 shows the time period  $T_d$  corresponding to one macro block line. Although the start timing of decoding a B picture is delayed by one macro block line period  $T_d$  relative to assertion of the signal PSYNC, the time difference between the start of decoding of the B picture and the reading of the decoded picture is one field time period plus one macro block line. The embodiment of Fig. 12 is an improvement of embodiment 1 and others as recited in the specification. That is, embodiment 2 indicates the time difference between the picture decoding start and the picture reading start. Delay of one macro block line is not singly employed in embodiment 2. Dependent claims 2, 9, 16 and 22 each require the one macro block line delay. Fig. 12 clearly indicates such relation. It is submitted that the B picture, I picture and P picture subject matter is clearly recited in claim 1. It is urged, therefore, that the claims particularly point out and distinctly claim the invention as required by statute. Withdrawal of the rejection is solicited. Moreover, as claims 1 through 3, 21 through 23, 27 and 28 have not

been rejected on the basis of prior art, and the rejection of these claims under 35 U. S. C. §112 is untenable for the reasons set forth above, it is submitted that these claims are now in condition for allowance.

Claims 8 through 10 have been rejected under 35 U. S. C. §102(e) as being anticipated by Auld. Reference is made in the Office Action to an earlier Office Action for the rationale for rejection. Reference is made to Fig. 5 of Auld for disclosing that picture P2 is different from picture 1, which comprises P1, F1. It is thus contended therein that this arrangement meets the subject matter recited in claim 8. Reconsideration of this rejection is respectfully requested.

The last paragraph of claim 8 recites "making said decoding means start decoding processing of a subsequent frame...in response to reading of a last field of a certain frame, the subsequent frame supplied immediately following a picture having the decoding processing completed upon reading of the last field."

If the claimed subject matter is to be compared with Auld, the claimed "said picture" corresponds to the pictures P1A and P1B of Auld, the claimed "said certain frame" corresponds to the pictures P1F1 and P1F2 upon reading in Auld, and the claimed "subsequent frame" corresponds to the pictures P2A and P2B in Auld. In Auld, the decoded pictures are subsequently read out for display, and the decoded picture (P1A/B) and the read out picture (P1F1/2) are the same in any case.

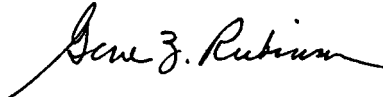
Claim 8 requires that the decoded picture (b) and the read out picture (I/P) are different pictures, as shown in Fig. 4 of the present application. Claim 8 recites that the picture (which would correspond to Auld's P1A/B in the above comparison) is different from the certain frame (which would correspond to Auld's picture P1F1/2 in the above

comparison). The Office Action, it is submitted, reads the claim requirement improperly on Auld's disclosure of non-corresponding decoded and read out pictures to arrive at the conclusion of anticipation.

Accordingly, it is urged that the application is now in condition for allowance. Favorable reconsideration of this application is respectfully requested. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



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